

REMARKS

In the final Office Action mailed January 2, 2003 ("Office Action"), the Patent Office stated that claims 1-20 are pending and that claims 1-20 stand rejected.

Allegation that the declaration is defective

In the Office Action, the Patent Office alleged that the declaration is defective in that the title of the invention in the declaration is different than the title of the invention on the first page of the specification. A corrected declaration will be filed as soon as possible. Pursuant to 37 C.F.R. § 1.48(a), the applicants will also respectfully request that the inventorship for the present application be changed to reflect the fact that Penny Towne, Joseph Utermohlen, Chad Wilkinson, Paula Rodgers, Kimberly Christensen, Noemi Sebastiao, and Ethel Macrea contributed to the conception and reduction to practice of the claimed invention. The requisite statement pursuant to 37 C.F.R. § 1.48(a)(2) will also be filed as soon as possible. Accompanying this Response is a signed Consent of the Assignee pursuant to 37 C.F.R. § 1.48(a)(5)

Rejection of claims 1-20 under 35 U.S.C. § 103(a)

In the Office Action, the Patent Office rejected claims 1-20 under 35 U.S.C. 103(a), as allegedly being obvious over Richards *et al.* (U.S. Patent No. 6,296,809) in view of Hartman *et al.*

As previously stated in the Response filed November 1, 2002, the applicants respectfully, yet strenuously, disagree with the Patent Office's allegation that the present invention is obvious over Richards *et al.* in view of Hartman *et al.*. None of the art cited by the Patent Office, alone or in any combination, mentions or even suggests the claimed invention. The presently claimed composition comprises a citrate buffer, ethylene glycol, sodium metabisulfite and sodium dodecyl sulfate (SDS). Such a composition is not disclosed in any of the cited art nor in any combination of the cited art. The applicants respectfully assert that the Patent Office is using forbidden hindsight reconstruction in its rejection of the pending claims.

As the Patent Office well knows, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to either modify or combine reference teachings. Also, there must be a reasonable expectation of success and the prior art reference or combined references must teach or suggest all of the claim limitations. Furthermore, both the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not in the applicant's disclosure. Finally, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In re Jones*, 958 F.2d 347; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

The applicants respectfully reiterate that the Richards *et al.* patent, upon which the Patent Office bases its 35 U.S.C. § 103(a) rejection, only mentions SDS and ethylene glycol in the most general manner as "preferably added to the conditioning solution." No specific concentration(s) or percentage(s) are provided. Furthermore, and with all due respect, the Patent Office erroneously states, in reference to the '809 patent, that "[t]he conditioning composition has a known molarity, pH and composition." The Richards *et al.* patent only states that "[t]he solutions should generally have known molarity, pH, and composition." Column 16, lines 13-14. Close examination of the disclosure of the Richards *et al.* patent reveals that not a single specific concentration or percentage are given for the citrate buffer, SDS, or ethylene glycol. At line 52 of column 19, Richards *et al.* only mention "Citrate Buffer" as the cell conditioning buffer. Thus, again with all due respect, it is difficult, if not impossible, to see how the disclosure of the '809 patent could possibly render the presently claimed compositions obvious to a person of ordinary skill in the art.

Similarly, while Hartman *et al.* discloses a fixative formulation comprising a bisulfite salt in an acidic buffer, which may or may not be citrate buffer, they do not mention, or even suggest, the inclusion of SDS or ethylene glycol in the fixative formulation. In fact, the disclosure of Hartman *et al.* mentions at numerous places that the preferred fixative formulation consists of only a bisulfite salt and an acidic buffer (*see e.g.*, column 2, lines 55-58; Example 1, column 3,

lines 40-52; and Example 2, column 3, lines 54-60). Thus, Hartman *et al.* actually teaches away from the compositions claimed in the present application.

None of the art cited by the Patent Office, either alone or in any combination, mentions, or even suggests, the compositions claimed in the present application. The claimed compositions were solely the invention of the present inventors and first disclosed in the present application.

In light of the foregoing, the applicants respectfully request that the rejection of claims 1-20 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

CONCLUSION

Entry of the amendments and consideration of the remarks herein is respectfully requested. A request to correct the inventorship of the present patent application as well as the requisite documentation to support the request will be filed as soon as possible. The applicants respectfully submit that the pending claims are allowable. The applicants urge the Patent Office to contact the applicants' undersigned representative if it is believed this would expedite prosecution of the present application. Prompt issuance of a Notice of Allowance and passage of the claims to issue are respectfully requested.

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Respectfully submitted,



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